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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,789	08/29/2001	Nathan Henderson	06-540	2943

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EXAMINER	
CAO, CHUN	

ART UNIT	PAPER NUMBER
2115	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/942,789	HENDERSON ET AL.	
	Examiner	Art Unit	
	Chun Cao	2115	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

FINAL REJECTION

1. Claims 1-27 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/14/08 has been entered.

3. The text of those applicable section of Title 35, U.S. Code not included in this action can be found in the prior Office Action.

4. The rejections are respectfully maintain and reproduced infra for applicant's convenience.

5. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Hwang et al. (Hwang), U.S. publication no. 2002/0188875[1].

As per claim 1, Hwang discloses a computer system comprising:

a host processor including resources supporting a full power mode, a lower power mode and a power down mode; and a network interface coupled to the host processor via a system bus, and coupled to a network [fig. 4; paragraphs 0009, 0070] , the network interface comprising:

[1] Hwang is cited in prior office action.

a memory that stores data packets in transit between the host processor and the network [Figure 3; paragraph 0024];

a medium interface unit coupled to network media supporting at least a high speed protocol and a lower speed protocol [paragraph 0024];

a voltage detector for detecting power supply voltage on the system bus [paragraphs 0075, 0083]; and

power management logic which forces the medium interface unit from high speed protocol to the lower speed protocol in response to an event detected by the voltage detector signally entry of said lower power mode [figure 6; paragraphs 0078, 0082, 0084].

As per claim 2, Hwang discloses that the network interface in said lower power mode consumes less than a specified power when executing said lower speed protocol, and consumes greater than the specified power when executing said high speed protocol [paragraph 0082].

As per claim 3, Hwang discloses that the network interface in said lower power mode consumes less than a specified power of about 1.3 watts, and the network interface requires greater than the specified power to support said high speed protocol [paragraph 0053].

As per claim 4, Hwang discloses that the network interface includes logic operating in the lower power mode using the lower speed protocol to detect a pattern in incoming packets, and in response to detection of said pattern, to issue a reset signal to the host processor [paragraph 0072].

As per claim 5, Hwang discloses that the medium interface unit comprises circuitry for formatting packets according to protocols compliant with 10 Megabit, 100 Megabit and Gigabit Ethernet protocol standards, and wherein said high speed protocol is Gigabit Ethernet, and said lower speed protocol is one of 10 Megabit Ethernet and 100 megabit Ethernet [paragraph 0024].

As per claim 6, Hwang discloses that the medium interface unit comprises circuitry for formatting packets according to a protocol compliant with an InfiniBand protocol standard, and wherein said high speed protocol is InfiniBand [paragraph 0024].

As per claim 7, Hwang discloses that host processor monitors the network interface for a wake up event involving a loss of link or a change of link on the network interface, and wherein said power management logic blocks signals indicating said wake up event for a time interval during the power management logic circuitry forces the medium interface unit to the lower speed protocol [Figure 6; paragraphs 0082-0084]

As per claim 8, Hwang discloses event detected by the voltage detector signaling lower power mode is a signal generated by the host processor [paragraphs 0082-0084].

As per claim 9, Hwang discloses that the system bus has a full power mode, a lower power mode and a power down mode, and said event detected by the voltage detector signaling lower power mode comprises a loss of power on the system bus [paragraphs 0073; 0082-0084].

As to claims 10-18, claims 1-9 basically are the corresponding elements that are carried out the method of operating steps in claims 10-18. Accordingly, claims 10-18 are rejected for the same reason as set forth in claims 1-9.

As to claims 19-27 are contained the same limitations as claims 1-9. Therefore, same rejection is applied.

Response to Arguments

6. Applicant's arguments filed 4/14/2008 have been fully considered but are not persuasive.

7. The declaration filed on 2/27/2008 under 37 CFR 1.131 has been considered but is still ineffective to overcome the Hwang reference (U.S. publication no. 2002/0188875).

8. Based on the evidence supplied, it appears that applicant is relying on conception prior to the effective date of the reference, followed by diligence until the US filing date.

9. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Hwang reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthalerv. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Per MPEP 715,

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. **FACTS**, **not conclusions, must be alleged**. Evidence in the form of exhibits may accompany the affidavit or declaration. **Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show**.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect

that his or her invention was conceived or reduced to practice prior to the reference date, **without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.**

When reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." **An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself.** Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out **exactly** what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

In generall proof of actual reduction to practice requires ashowing thattheapparatus actually existed and worked for its intended purpose.

10. The declaration and the accompanying exhibit do not provide enough evidence to support all the claimed limitations prior to the reference date, therefore does not support conception of the claimed invention. For example, there is no explanation of the exhibit or positive statement on the declaration to support the limitations of all claims (claims 1-27). Applicant did not give a clear explanation pointing out **exactly** what facts are established and relied upon from the exhibit with respect to those particular limitations. It is to be understood that there are claimed limitations that are not sufficiently supported by the evidence provided by the declaration and the accompanying exhibit.

11. Per MPEP 2138.06,

THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES

An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough,); In re Harry, 333 F.2d 920, 923, 142 USPQ 1M, 166 (CCPA 1964) (**statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal.** In re Mulder. 716 F.2d 1+2, 1M5, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530. 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (**Diligence requires that applicants must be specific as to dates and facts.**).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (**Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field)**; Griffith v. Kanamaru, 816 F.2d 624, 2 USPQZd 1361 (Fed. Cir.1987) (Court generally reviewed cases on excuses for inactivity induding vacation extended by ill health and **daily job demands**, and held lack of university funding and personnel **are not acceptable excuses.)**; Litchfield v. Eigen, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); Morway v. Bondi, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); Anderson v. Crowther, 152 USPQ 504. 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); Wu v. Jucker, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); Tucker v. Natta, 171 USPQ 494,498 (Bd. Pat. Inter. 1971) ("[a]ctivity directed toward the reduction to practice of a genus does not establish, prima facie, diligence toward the reduction to practice of a species embraced by said genus"); Justus v. Appenzeller, 177 USPQ

332, 34G.1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....").

The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. Conception was established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor. Conception is less a matter of signature than it is one of disclosure. Attorney does not prepare a patent application on behalf of particular named persons, but on behalf of the true inventive entity. **Six days to execute and file application is acceptable**. Haskell v. Coleburne, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). See also Bey v. Kollonitsch, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. **Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient**. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.).

The evidence submitted is insufficient to establish diligence from a date prior to the effective date of the Hwang reference (April 24, 2001) to the US filing date of this application (August 21, 2001) because there are several periods lacking activity **(a 2-day period lacking activity has been held to be fatal)**.

In declaration paragraphs 12-14 and the remark, applicant merely provided blanket statements to support diligence between August 13, 2001 to August 29, 2001, without being specific as to dates and facts. Furthermore, it is noted that applicant's daily job demands (applicant's normal workload) are not acceptable excuses for inactivity. Since In declaration paragraphs 12-14 and the remark did not cover all the specifics as to dates and facts, they are insufficient to establish diligence between August 13, 2001 and August 29, 2001.

There is no activity between 08/13/2001 and 08/23/2001 (Exhibit G shows activities only for 08/13/2001, and Exhibit H shows activities only for 08/23/2001), and there is no statement by the applicant declaring "any period between 08/13/2001 and 08/23/2001 during which the invention was not worked on was due to normal workload associated with the applicant".

There is no activity between 08/23/2001 and 08/29/2001 (Exhibit H shows activities only for 08/23/2001), and there is no statement by the applicant declaring "any period between 08/23/2001 and 08/29/2001 during which the invention was not worked on was due to normal workload associated with the applicant".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chun Cao whose telephone number is 571-272-3664. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 30, 2008
/Chun Cao/
Primary Examiner, Art Unit 2115